

**REMARKS****Paragraphs 1-4 of the Office Action**

Claims 1, 2, and 5 are rejected under 35 USC §102(b) as being anticipated by  
5 Elias. Claims 3, 4 and 6-9 are rejected under 35 U.S.C. §103(a) as being unpatentable  
over Elias as applied to claims above, and further in view of teachings of McEwan.

Claims 3, 4 and 8 have been cancelled. Claim 1 has been amended and now  
includes the limitations of as-filed claim 3 and the limitation that the lip, as clearly shown  
in figure 3, is orientated generally perpendicular to the peripheral wall. As to claims 6, 7  
10 and 9, each includes the limitation of an elastic band that is attached to the peripheral  
wall. These limitations are important to the usefulness of applicant's device because,  
unlike a conventional prophylactic, applicant's device is made to be held onto a penis  
when it is substantially flaccid. The lip, in particular, will fit snugly along the base of  
the head of the penis while the elastic band provides even more tension along the opening  
15 of the peripheral wall to frictionally hold the peripheral wall against the penis.

McEwan is cited for showing a shape adapted for receiving a head of a penis.  
However, it is respectfully submitted that McEwan only discloses a head which is  
enlarged with respect to the sheath and therefore constitutes only an enlarged cylindrical  
portion and not a lip as is found in applicant's amended claim 1 and original claim 9. For  
20 the reasons stated above, the lip is of significant importance to the functionality of  
applicant's device.

McEwan is also cited for finding an elastomeric band, however, McEwan does  
not assert an added band as applicant has. McEwan only shows an open end 13. This  
end may be depicted as being widened with respect to the sheath 11, but such is typically  
25 true of male prophylactic devices. However, an added elastomeric band, which applicant  
uses, is neither shown in McEwan and is not typical of prophylactics. Open end 13 is  
exactly what it states, the open end, perhaps bulbous in order to allow for easy gripping  
and rolling, but it is not an elastomeric band for increasing friction. The band of  
applicant's device, aside from increasing friction between the peripheral wall and the  
30 penis, also aids in preventing the rolling up of the peripheral wall. This is of great  
importance as applicant's device will be typically worn under clothing which will be

abutting the sheath. Movement of the clothing against the sheath, absent the band, will cause the sheath to roll up to the cap. The rolling of the peripheral wall may subsequently cause applicant's device to fall off of the penis. For these reasons, a separately attached band, as opposed to a widened section, is a significant improvement over the prior art.

For the reasons stated above, it is believed that neither the lip nor the band is shown in the prior art and as those features lead to functional differences between applicant's device and the prior art, there is no support for a 103 rejection. The applicant thereby respectfully requests withdrawal of the rejection.

**New claim 10**

New claim 10 includes the limitation of the band having a rectangular cross-section which is clearly shown in the figures. This limitation is not shown in the prior art and further differentiates applicant's device from McEwan and Elias. No new matter has been added and all references therein are fully supported in the specification and figures as originally filed.

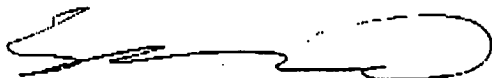
**CONCLUSION**

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In light of the foregoing amendments and remarks, early consideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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